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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/063,886 | 05/21/2002 | Hsu-Chu Chien | CHEP0006USA | 2361 |

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NAIPO (NORTH AMERICA INTERNATIONAL PATENT OFFICE)
P.O. BOX 506
MERRIFIELD, VA 22116

EXAMINER

FEGGINS, KRISTAL J

ART UNIT PAPER NUMBER

2861

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

10/063,886

Applicant(s)

CHIEN ET AL.

Examiner

K. Feggins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Sung et al. (US 6509920 B1).

Sung et al. disclose the following claimed limitations:

* regarding claim 1, a method (disclosed by the operation of the apparatus) for generating a watermark/printing of color dyes/ on a photo picture/object, receiver/ using a thermal printer (Abstract, col 2, lines 54-67);

* the thermal printer comprising a thermal printhead/74/ for heating an ink ribbon/42. and generating an image through the ink ribbon on a photo picture/receiver/ (col 2, lines 54-67);

* the ink ribbon comprising a plurality of sequentially arranged color frames, each color frame comprising a plurality of dye frames with different color dyes and a dye frame with overcoating (col 2, lines 54-62, col 6, lines 1-8, figs 2 & 6);

* the method comprising: using the thermal printhead to heat a color frame with a plurality of different color dyes and to sublimate the color dyes on a photo picture (col 2, lines 54-62, col 6 1-8, figs 2 & 6)

* using the thermal printhead to heat the dye frame with the overcoating and to heat a different area on the dye frame by two distinct time periods (col 2, lines 54-62, col 6, lines 1-8, figs 2 & 6) /each color frame and the overcoating frame of the ink ribbon is recorded upon at different/distinct/ time periods. The color and the overcoating frames are moved at different/distinct/ times for printing./.

* regarding claim 2 ; wherein each color frame storing yellow, magenta, and cyan dye; the recited structure limitations does not manipulate the method steps recited in claim 1. Therefore they do not further define the method of claim 1.

* regarding claim 3; wherein the thermal printer further comprises a winding mechanism for driving the ink ribbon to generate a shift between the thermal printhead and the ink ribbon; the recited structure limitations does not manipulate the method steps recited in claim 1; therefore they do not further define the method of claim 1.

* regarding claim 4; wherein the thermal printhead is capable of heating different areas on each dye frame stored with different color dyes by a plurality of different time periods, so as to print an image on a photo picture; the recited structure limitations does

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not manipulate the method steps recited in claim 1; therefore they do not further define the method of claim 1.

* regarding claim 5; wherein the thermal printhead is capable of heating different areas on a dye frame stored with overcoating by two distinct time periods, so as to print an image-shaped overcoating on a photo picture; the recited structure limitations does not manipulate the method steps recited in claim 1; therefore they do not further define the method of claim 1.

* regarding claim 6; wherein the thermal printer further comprises a controller for adjusting a heating time period for the thermal printhead to heat different areas on each color frame; the recited structure limitations does not manipulate the method steps recited in claim 1; therefore they do not further define the method of claim 1.

Response to Arguments

3. Applicant's arguments filed 4 Jul 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that the reference does not disclose "using the thermal printhead to heat the dye frame with the overcoating and to heat a different area on the dye frame by two distinct time periods" is acknowledged. However, both Sung et al. and Katsuda et al. disclose a method that utilized a thermal printhead and a ribbon (dye colors frames and overcoating frame). Different areas on the dye frame are heated at two different time periods or "to heat a different area on the dye frame by two

distinct time periods". Figure 6 of Sung et al. disclose the heating of an ink ribbon containing an overcoating wherein different areas of the ribbon is heated at 2 distinct or 2 different time periods. Katsuda et al., figures 1, disclose an ink ribbon with an overcoating layer and figure 8 disclose the different time periods in which the ribbon is heated (the heating is performed by using a thermal printhead.)

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., ...to dispose different thicknesses of overcoating) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Katsuda et al. (US 6,130,698) disclose a heat transfer printer that produces an image on a sheet by heating an ink member wherein there is a region for insulating heat produced within the overcoat material transfer region.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

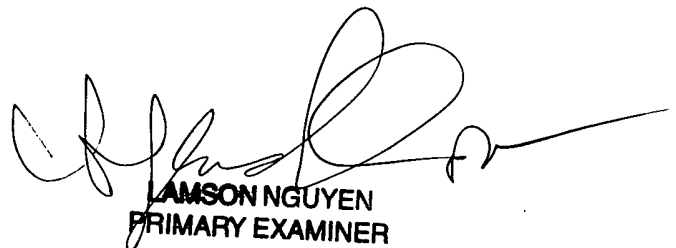
Communication With The USPTO

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to K. Feggins whose telephone number is 703-306-4548. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, B. Fuller can be reached on 703-308-0079. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

K Feggins
K. Feggins
September 17, 2003


LAMSON NGUYEN
PRIMARY EXAMINER